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11 Telephone (858) 362-3151  
12 michael@kalerlaw.com

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15 Attorneys for Plaintiff JENS ERIK SORENSEN,  
16 as Trustee of SORENSEN RESEARCH AND  
17 DEVELOPMENT TRUST

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UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF CALIFORNIA

JENS ERIK SORENSEN, as Trustee of ) Case No. 08 cv 309 BTM CAB  
SORENSEN RESEARCH AND )  
DEVELOPMENT TRUST, )  
Plaintiff )  
v. )  
CENTRAL PURCHASING, LLC, a )  
California Corporation; and DOES 1 – )  
100, )  
Defendants. )  
Case No. 08 cv 309 BTM CAB )  
DECLARATION OF MELODY A. )  
KRAMER IN SUPPORT OF PLAINTIFF'S )  
MOTION TO MODIFY PATENT LOCAL )  
RULES SCHEDULE TO ACCELERATE )  
IDENTIFICATION OF CLAIMED )  
INVALIDATING PRIOR ART )  
Date: June 20, 2008 )  
Time: 11:00 a.m. )  
Hon. Barry T. Moskowitz )  
NO ORAL ARGUMENTS UNLESS )  
ORDERED BY THE COURT )

1 I, MELODY A. KRAMER, declare:

2 1. I am not a party to the present action. I am over the age of eighteen. I  
3 have personal knowledge of the facts contained within the following paragraphs, and  
4 could and would competently testify thereto if called as a witness in a court of law.

5 2. At all times relevant herein I have been an attorney for Sorensen  
6 Research and Development Trust (“Sorensen”), Plaintiff in the above-captioned  
7 matter. This declaration is made in support of Plaintiff’s Motion to Modify Patent  
8 Local Rules Schedule to Accelerate Identification of Claimed Invalidating Prior Art.

9 3. It is anticipated that Defendant will make a pro forma affirmative  
10 defense and/or counterclaim for declaratory relief of patent invalidity without detail  
11 as have every other answering defendant in these related cases.

12 4. In July 2007 and December 2007, respectively, defendants in the related  
13 Black & Decker case<sup>1</sup> filed requests for *ex parte* reexamination of the ‘184 patent  
14 with the USPTO. Attached hereto as Exhibit A and B are true and correct copies of  
15 relevant pages of said Requests for Ex Parte Reexamination.

16 5. The prior art cited in the second *ex parte* request contained several prior  
17 art references that had not been disclosed to Sorensen in either of the parties’  
18 Preliminary Invalidity Contentions served on February 2, 2007 (Exhibit C), nor the  
19 Amended Preliminary Invalidity Contentions served on March 5, 2007 (Exhibit D),  
20 nor the first *ex parte* request (Exhibit A). Attached hereto as Exhibits C and D are  
21 true and correct copies of Black & Decker’s Preliminary Invalidity Contentions and  
22 Amended Preliminary Invalidity Contentions.

23 6. In the course of the present reexamination proceedings, Sorensen has, to  
24 our knowledge, identified to the USPTO all claimed invalidating prior art identified  
25 to Sorensen to date from any source.

26 7. Although Sorensen has been in contact with Defendants in this case pre-

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28 <sup>1</sup> *Sorensen v. Black & Decker Corporation, et al*, Case No. 06cv1572

1 litigation regarding the '184 patent, none of the correspondence from Defendants  
2 constitutes any type of binding assertion of all claimed prior art or other claimed  
3 basis for invalidity of the '184 patent. Thus, Sorensen has been unable to ensure that  
4 these Defendants' asserted invalidated prior art will be reviewed by the USPTO.

5 8. Attached hereto as Exhibit E is a true and correct copy of a document  
6 from the USPTO explaining a rule change regarding successive reexaminations on  
7 the same patent.

8  
9  
10 DATED this Friday, April 04, 2008.

11  
12 /s/ Melody A. Kramer  
13 

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Melody A. Kramer, Esq.  
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## **EXHIBIT A**

(Also referred to as FORM PTO-1465)

**REQUEST FOR EX PARTE REEXAMINATION TRANSMITTAL FORM**

Address to:

**Mail Stop *Ex Parte* Reexam**  
**Commissioner for Patents**  
**P. O. Box 1450**  
**Alexandria, VA 22313-1450**

**Attorney Docket No.: X32441****Date: July 30, 2007**

1.  This is a request for *ex parte* reexamination pursuant to 37 CFR 1.510 of patent number 4,935,184 issued June 19, 1990. The request is made by:
  - patent owner.
  - third party requester.
2.  The name and address of the person requesting reexamination is:
 

Arnold Turk, Esq.  
Greenblum & Bernstein, P.L.C.  
1950 Roland Clarke Place, Reston, VA 20191
3.  a. A check in the amount of \$ 2,520.00 is enclosed to cover the reexamination fee, 37 CFR 1.20(c)(1);
  - b. The Director is hereby authorized to charge the fee as set forth in 37 CFR 1.20(c)(1) to Deposit Account No. 19-0089 (submit duplicative copy for fee processing); or
  - c. Payment by credit card. Form PTO-2038 is attached.
4.  Any refund should be made by  check or  credit to Deposit Account No. 19-0089. 37 CFR 1.26(c). If payment is made by credit card, refund must be to credit card account.
5.  A copy of the patent to be reexamined having a double column format on one side of a separate paper is enclosed. 37 CFR 1.510(b)(4)
6.  CD-ROM or CD-R in duplicate, Computer Program (Appendix) or large table
  - Landscape Table on CD
7.  Nucleotide and/or Amino Acid Sequence Submission  
*If applicable, items a. – c. are required.*
  - a.  Computer Readable Form (CRF)
  - b. Specification Sequence Listing on:
    - i.  CD-ROM (2 copies) or CD-R (2 copies); or
    - ii.  paper
  - c.  Statements verifying identity of above copies
8.  A copy of any disclaimer, certificate of correction or reexamination certificate issued in the patent is included.
9.  Reexamination of claim(s) 1, 2, 4, 6-10 is requested.
10.  A copy of every patent or printed publication relied upon is submitted herewith including a listing thereof on Form PTO/SB/08, PTO-1449, or equivalent.
11.  An English language translation of all necessary and pertinent non-English language patents and/or printed publications is included.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.510. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. § 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS: SEND TO: **Mail Stop *Ex Parte* Reexam, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

12.  The attached detailed request includes at least the following items:

- A statement identifying each substantial new question of patentability based on prior patents and printed publications. 37 CFR 1.510(b)(1)
- An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited art to every claim for which reexamination is requested. 37 CFR 1.510(b)(2)

13.  A proposed amendment is included (only where the patent owner is the requester). 37 CFR 1.510(e)

14.  a. It is certified that a copy of this request (if filed by other than the patent owner) has been served in its entirety on the patent owner as provided in 37 CFR 1.33(c).  
The name and address of the party served and the date of service are:

James Michael Kaler Edward W. Callan  
The Law Offices of James M. Kaler 3830 Valley Center Drive, No. 705, PMB452  
9930 Mesa Rim Road Suite 200, San Diego, CA 92121 San Diego, CA 92130

Date of Service: July 30, 2007 ; or

b. A duplicate copy is enclosed since service on patent owner was not possible.

15. Correspondence Address: Direct all communication about the reexamination to:

The address associated with Customer Number: 07055  
 OR

Firm or  
Individual Name Greenblum & Bernstein, P.L.C.

Address  
1950 Roland Clarke Place

City	Reston	State	VA	Zip	20191
------	--------	-------	----	-----	-------

Country	United States
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Telephone	(703) 716-1191	Email	atuk@gbpatent.com
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16.  The patent is currently the subject of the following concurrent proceeding(s):

a. Copending reissue Application No. \_\_\_\_\_  
 b. Copending reexamination Control No. \_\_\_\_\_  
 c. Copending Interference No. \_\_\_\_\_  
 d. Copending litigation styled:  
(1) Jens E. Sorensen v. Black Decker (U.S.) Inc., et al., Civil Action No. 06-cv-1572  
(2) Jens E. Sorensen v. Tecnica USA Corp. and Nordica USA Corp., Civil Action No. 06-cv-1941  
(3) Previous litigation listed in Request

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

  
\_\_\_\_\_  
Authorized Signature

July 30, 2007

Date

_____ Arnold Turk Typed/Printed Name	<u>33094</u> Registration No.	<input type="checkbox"/> For Patent Owner Requester <input checked="" type="checkbox"/> For Third Party Requester
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Attorney Docket No. X32441  
 Attorney Docket No. SOR-BD-184  
 Request for Reexamination of U.S. Patent No. 4,935,184

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor:	Jens Ole Sorensen	)
		)
Patent No.:	4,935,184	)
		)
Issue Date:	June 19, 1990	)
		)
Filing Date:	July 27, 1989	)
		)
Title:	Stabilized Injection Molding	)
	When Using A Common	)
	Mold Part With Separate	)
	Complimentary Mold Parts	)

**Mail Stop *Ex Parte* Reexam**  
 Central Reexamination Unit  
 Commissioner for Patents  
 United States Patent & Trademark Office  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

**REQUEST FOR *EX PARTE* REEXAMINATION**  
**PURSUANT TO 35 U.S.C. § 302 AND 37 C.F.R. 1.510**

Pursuant to 35 U.S.C. § 302 and 37 C.F.R. § 1.510, the Third Party Requester hereby requests that reexamination of the above-identified patent be ordered by the U.S. Patent & Trademark Office.

**I. CLAIMS FOR REEXAMINATION**

Reexamination of claims 1, 2, 4 and 6-10 of U.S. Patent No. 4,935,184 ("the '184 patent") is requested and believed to be in order. The '184 patent is not expired and is still enforceable. A copy of the '184 patent is attached hereto as Appendix A as required by 37 C.F.R. § 1.510(b)(4).

Attorney Docket No. SOR-BD-184  
Request for Reexamination of U.S. Patent No. 4,935,184

## II. SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

Substantial new questions of patentability are raised based upon the following patents and printed publications:

<b>Patents and Published Patent Applications</b>				
Reference Number	Country	Applicant or Assignee	Issue Date	Statutory Basis
2,863,241	U.S.	Gits	12/09/58	102(b)
3,178,497	U.S.	Moscicki	04/13/65	102(b), 103(a)
4,422,995	U.S.	Schad	12/27/83	103(a)
4,440,820	U.S.	Shiho et al.	04/03/84	102(b), 103(a)
1 850 999	Germany (DE)	Echterholter	05/03/62 (published)	102(b), 103(a)
2 004 494	U.K. (GB)	SEIMA	04/04/79 (published)	102(b), 103(a)
60-119520	Japan (JP)	Toyota Motor	08/13/85 (published)	102(b), 103(a)

  

<b>Printed Publications</b>			
Source	Title	Publication Date	Statutory Basis
Modern Plastics	New Vigor For Two-Shot Molding With Automation . . . Versatility . . . Ingenuity	05/68	102(b), 103(a)

A copy of each reference that has a bearing on the patentability of the claims of the '184 patent (including English translations thereof as appropriate) is enclosed in Appendix B herewith in accordance with 37 C.F.R. § 1.510(b)(3). The cover page of Appendix B lists the identified references in a PTO/SB/08 form.

With the exception of the Schad reference, none of the other identified references were cited by either the applicant or the Examiner during prosecution of the application that issued as the '184 patent. These newly cited references are more relevant than the art cited and considered during prosecution of the '184 patent.

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number		
	Filing Date		
	First Named Inventor		
	Art Unit		
	Examiner Name		
	Attorney Docket Number	REQUEST FOR REEXAMINATION	

U.S.PATENTS						
Examiner Initial*	Cite No	Patent Number	Kind Code <sup>1</sup>	Issue Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear
	1	2863241		1958-12-09	Gits	all
	2	3178497		1965-04-13	Moscicki	all
	3	4422995		1983-12-27	Schad	all
	4	4440820		1984-04-03	Shiho	all

If you wish to add additional U.S. Patent citation information please click the Add button.

U.S.PATENT APPLICATION PUBLICATIONS						
Examiner Initial*	Cite No	Publication Number	Kind Code <sup>1</sup>	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear
	1					

If you wish to add additional U.S. Published Application citation information please click the Add button.

FOREIGN PATENT DOCUMENTS								
Examiner Initial*	Cite No	Foreign Document Number <sup>3</sup>	Country Code <sup>2</sup>	Kind Code <sup>4</sup>	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear	T <sup>5</sup>

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number			
	Filing Date			
	First Named Inventor			
	Art Unit			
	Examiner Name			
	Attorney Docket Number		REQUEST FOR REEXAMINATION	

	1	1 850 999	DE		1962-05-03	Echterholter	all	<input checked="" type="checkbox"/>
	2	2 004 494	GB		1979-04-04	SEIMA	all	<input checked="" type="checkbox"/>
	3	60-119520	JP		1985-08-13	Toyota Motor	all	<input checked="" type="checkbox"/>

If you wish to add additional Foreign Patent Document citation information please click the Add button

#### NON-PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T5
	1	VAL WRIGHT, New Vigor For Two-Shot Molding With Automation . . . Versatility . . . Ingenuity, Modern Plastics, May 1968, pages 79-83, published in US	<input type="checkbox"/>

If you wish to add additional non-patent literature document citation information please click the Add button

#### EXAMINER SIGNATURE

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> See Kind Codes of USPTO Patent Documents at [www.USPTO.GOV](http://www.USPTO.GOV) or MPEP 901.04. <sup>2</sup> Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>3</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>4</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>5</sup> Applicant is to place a check mark here if English language translation is attached.

## **EXHIBIT B**

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

<p>Substitute for form 1449/PTO</p> <p><b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b></p> <p>Date Submitted: December 21, 2007</p>				<p><b>Complete if Known</b></p>	
Sheet	1	of	2	<b>Reexamination Control Number</b>	Unassigned
				<b>Patent Number</b>	4,935,184
				<b>First Named Inventor</b>	Jens O. Sorensen
				<b>Attorney Docket Number</b>	065640-0260

## U.S. PATENT DOCUMENTS

UNPUBLISHED U.S. PATENT APPLICATION DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	U.S. Patent Application Document	Filing Date of Cited Document MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Serial Number-Kind Code <sup>2</sup> (if known)			

## FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Documents	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup> Number <sup>4</sup> Kind Code <sup>5</sup> (if known)				
	A5	JP 59-199227	11/12/1984	IDEMITSU SEKIYU KAGAKU KK		Tr.
	A6	JP 60-154022	08/13/1985	FUJITSU, LTD.		Tr.
	A7	JP 58-82401	05/18/1983	NISSAN MOTOR CO., LTD.		Tr.
	A8	JP S52-51449	04/25/1977	KABUSHIKI KAISHA YOSHINO KOGYOSHO		Tr.

## NON-PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>6</sup>
	A9	SUMITOMO HEAVY INDUSTRIES, LTD., <i>Promat 100-100/100 Sumitomo-Netstal Dual Material Injection Molding Machine</i>	Tr.

Examiner Signature		Date Considered	
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. 3 Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). 4 For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. 5 Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. 6 Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449/PTO

**Complete if Known****INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

Date Submitted: December 21, 2007

**Reexamination Control  
Number**

Unassigned

**Patent Number**

4,935,184

**First Named Inventor**

Jens O. Sorensen

Sheet

2

of

2

Attorney Docket Number

065640-0260

**NON PATENT LITERATURE DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>6</sup>
	A10	WRIGHT, "New Vigor for Two-Shot Molding with Automation," <i>Modern Plastics</i> , Vol. 45, No. 9, May 1968, pp. 78 – 83.	
	A11	Plaintiff's Amended Preliminary Claim Constructions and Extrinsic Evidence, SORENSEN v. THE BLACK & DECKER CORPORATION ET AL., U.S. District Court for the Southern District of California, Case No. 06-cv-1572 BTM (CAB).	
	A12	SORENSEN v. INTERNATIONAL TRADE COM'N., 427 F.3d 1375 (Fed. Cir. 2005)	
	A13	Deposition of Paul P. Brown, December 19, 2006, SORENSEN v. THE BLACK & DECKER CORPORATION ET AL., U.S. District Court for the Southern District of California, Case No. 06-cv-1572 BTM (CAB).	
	A14	Plaintiffs' Local Civil Rule 56.1 Statement of Material Facts in Opposition to Defendants' Motion for Summary Judgment of Invalidity Based on Prior Art, U.S. District Court for the District of New Jersey Newark Vicinage, CIV. No. 03-1763(HAA).	

Examiner  
SignatureDate  
Considered

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. 3 Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). 4 For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. 5 Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. 6 Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor:	Jens Ole Sorensen	)
		)
Patent No.:	4,935,184	)
		)
Issue Date:	June 19, 1990	)
		)
Filing Date:	July 27, 1989	)
		)
Title:	Stabilized Injection Molding	)
	When Using A Common	)
	Mold Part With Separate	)
	Complimentary Mold Parts	)

Mail Stop ***Ex Parte Reexam***  
 Central Reexamination Unit  
 Commissioner for Patents  
 United States Patent & Trademark Office  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

**REQUEST FOR EX PARTE REEXAMINATION**  
**PURSUANT TO 35 U.S.C. § 302 AND 37 C.F.R. § 1.510**

Pursuant to 35 U.S.C. § 302 and 37 C.F.R. § 1.510, the Third Party Requester hereby requests that reexamination of the above-identified patent be ordered by the U.S. Patent & Trademark Office.

**I. CLAIMS FOR REEXAMINATION**

Reexamination of claims 1, 2, 4 and 6-10 of U.S. Patent No. 4,935,184 ("the '184 patent") is requested and believed to be in order. The '184 patent is not expired and is still in force. A copy of the '184 patent is attached hereto as Exhibit A as required by 37 C.F.R. § 1.510(b)(4).

Attorney Docket No 065640/0260  
Request for Reexamination of U.S. Patent No. 4,935,184

## II. SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

Substantial new questions of patentability are raised by the following patents and printed publications:

Patents and Published Patent Applications				
Reference No.	Country	Applicant or Assignee	Publication Date	Statutory Basis
S59-199227	Japan	Idemitsu Sekiyu Kagaku K.K.	11/12/84	102(b), 103(a)
60-154022	Japan	Fujitsu, Ltd.	08/13/85	102(b), 103(a)
4,422,995	United States	Robert D. Schad	12/27/83	102(b), 103(a)
58-82401	Japan	Nissan Motor Co., Ltd.	05/18/83	102(b), 103(a)
4,508,676	United States	Jens O. Sorensen	04/02/85	102(b), 103(a)
3,375,554	United States	Armin Blumer	04/02/68	102(b), 103(a)
S52-51449	Japan	Kabushiki Kaisha Yoshino Kogyosho	04/25/77	102(b), 103(a)

  

Printed Publications			
Source	Title	Publication Date	Statutory Basis
Sumitomo Heavy Indus., Ltd.	Promat 100-100/100	Admitted prior art	102(b),103(a)
Modern Plastics	New Vigor For Two-Shot Molding With Automation ... Versatility ... Ingenuity	May 1968	102(b),103(a)

A copy of each reference relied upon in this reexamination request (including any English translations) is enclosed in Exhibit B. *See* 37 C.F.R. § 1.510(b)(3). The identified references are listed in a PTO/SB/08 form, attached to this request. Except for Schad '995, Promat 100 and Sorensen '676 (all used only for secondary teachings), none of these references were cited during the original prosecution of the '184 patent. These newly cited references (or new combinations involving Schad '995, Promat 100 and Sorensen '676) are believed to be more relevant than the art cited and considered during original prosecution and, thus, raise substantial new questions of patentability. As discussed herein, the identified references anticipate or render obvious one or

## **EXHIBIT C**

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 5 San Diego, California 92121  
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 9 Dina M. Hayes (*Pro Hac Vice*)  
 10 Gregory P. Casimer (*Pro Hac Vice*)  
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 13 Chicago, Illinois 60602-4515  
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16 Attorneys for Defendant  
 17 The Black & Decker Corporation

18 **UNITED STATES DISTRICT COURT**  
 19 **FOR THE SOUTHERN DISTRICT OF CALIFORNIA**

20 JENS ERIK SORENSEN, as Trustee of  
 21 SORENSEN RESEARCH AND  
 22 DEVELOPMENT TRUST,

23 Plaintiff,

24 vs.

25 THE BLACK & DECKER CORPORATION,  
 26 Defendant.

27 Case No. 06cv1572 BTM (CAB)

28 **DEFENDANT'S PRELIMINARY  
 29 INVALIDITY CONTENTIONS  
 PURSUANT TO PATENT L.R. 3.3**

30 Defendant The Black & Decker Corporation ("Black & Decker") makes the following  
 31 disclosure of its Preliminary Invalidity Contentions as required under Patent L.R. 3.3.  
 32 Defendant currently has a motion pending for summary judgment of noninfringement based on  
 33 the fact that The Black & Decker Corporation does not make, use sell, offer for sale or import  
 34 any products at all, much less the products accused of infringement in this action. Plaintiff  
 35 currently has a motion pending to join additional parties as defendants to this action.  
 36 Accordingly, Defendant reserves the right to correct, amend, or modify these disclosures based  
 37 on the outcome of its summary judgment motion, and based upon which Black & Decker  
 38 subsidiaries, if any, are added to the litigation.

1 Plaintiff's preliminary infringement contentions pursuant to Patent L.R. 3.1 identify only  
 2 claim 1 of U.S. Patent No. 4,935,184 ("the '184 patent") as being asserted against Black &  
 3 Decker. If additional claims are asserted, Black & Decker reserves the right to supplement its  
 4 invalidity contentions to address all later asserted claims.

5 Black & Decker contends that Plaintiff's own claim construction contentions (as set  
 6 forth, for example, in Plaintiff's Memorandum in Support of Summary Determination of  
 7 Infringement, Doc. #33) render claim 1 invalid over the prior art. Black & Decker does not  
 8 agree with the Plaintiff's claim construction (in fact, Black & Decker contends that many of the  
 9 terms are incapable of reasonable construction as described in Section D. below) but has applied  
 10 it here so that the focus of the parties' dispute is on the technical substance of the prior art and  
 11 not on collateral claim construction issues. Black & Decker will set forth its complete claim  
 12 construction position in the time and manner required under Patent L.R. 4.1.

13 **A. The Identity of Prior Art**

14 Black & Decker identifies the following categories of prior art:

15 **Prior Art Patents**

<u>Patent Number</u>	<u>Country of Origin</u>	<u>Date of Issue</u>
2,510,091	U.S.	June 6, 1950
2,863,241	U.S.	December 9, 1958
3,164,864	U.S.	January 12, 1965
3,178,497	U.S.	April 13, 1965
3,466,700	U.S.	September 16, 1969
3,807,920	U.S.	April 30, 1974
4,242,391	U.S.	December 30, 1980
4,422,995	U.S.	December 27, 1983
4,440,820	U.S.	April 3, 1984

	<u>Patent Number</u>	<u>Country of Origin</u>	<u>Date of Issue</u>
1	4,459,256	U.S.	July 10, 1984
2	4,495,125	U.S.	January 22, 1985
3	4,585,686	U.S.	April 29, 1986
4	4,676,941	U.S.	June 30, 1987
5	4,743,422	U.S.	May 10, 1988
6	60-119520 (App. No. 59-7042)	Japan	August 13, 1985 (Pub. Date)
7	61-47223 (App. No. 59-169665)	Japan	March 7, 1986 (Pub. Date)
8	62- 279911	Japan	December 4, 1987 (Pub. Date)
9	55-071541 (App. No. 53-144859)	Japan	May 29, 1980 (Pub. Date)
10	App. No. GB 2004 494 A	UK	April 4, 1979 (Pub. Date)
11	Pub. No. WO 87/012329	PCT/Priority U.S.	March 12, 1987 (Pub. Date)

**Prior Art Publications**

	<u>Title</u>	<u>Date of Publication</u>	<u>Author</u>	<u>Publisher</u>
18	Multi-Color Injection Moulding Machines for the Processing of Thermoplastic Materials	1983	Reiner Jensen	Krauss-Maffei AG
19	Promat 100-100/100 by Nestal		Nestal	Nestal
20	New Vigor for Two-Shot Molding with Automation ... Versatility ... Ingenuity	May 1968	Val Wright	Modern Plastics

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**Prior Art Under 35 U.S.C. §102(b)**

<u>Description of Item</u>	<u>Action Date</u>	<u>First Party</u>	<u>Second Party</u>
Parking Brake Grip	9/10/82 to 7/2/86	Phillips Plastics Corp.	Atwood Automotive
Automotive pushbuttons	6/30/81 to 3/17/86	Phillips Plastics Corp.	Ford Motor Co.
Knob Infinite Switch	1/22/87 to 2/5/87	Phillips Plastics Corp.	Jenn-Air Corp.
Button Release Assembly	11/14/84 to 2/5/87	Phillips Plastics Corp.	Eastman Kodak
S Series Camera Body	6/14/86 to 2/5/87	Phillips Plastics Corp.	Eastman Kodak
Two Shot Knob	1/27/86 to 9/26/86	Phillips Plastics Corp.	TRW
Set-Coast Switch, Part No. B9207-C	8/8/85 to 10/85	Phillips Plastics Corp.	Methode Electronics
GM Part No. 16508729	12/85 to 2/5/87	Redoe Molding	General Motors
GM Part No. 16508885 - 886	12/85 to 2/5/87	Hallmark Technologies	General Motors
BMW 528i Part No. 63 21 1 361 603	1979	Krauss-Maffei AG	BMW

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**B. Whether each item of prior art anticipates each asserted claim or renders it**

**obvious.**

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Black & Decker contends that the following references anticipate claim 1 of the '184 patent: see Section C, Table 1.

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Black & Decker contends that the following references in combination render obvious

claim 1 of the '184 patent: see Section C, Table 2, and Table 3 Figures A, D, F and G.

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## **EXHIBIT D**

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Attorneys for Defendant  
The Black & Decker Corporation

**UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF CALIFORNIA**

JENS ERIK SORENSEN, as Trustee of  
SORENSEN RESEARCH AND  
DEVELOPMENT TRUST.

Plaintiff.

VS.

THE BLACK & DECKER CORPORATION,

Defendant.

Case No. 06cv1572 BTM (CAB)

**DEFENDANT'S AMENDED  
PRELIMINARY INVALIDITY  
CONTENTIONS PURSUANT TO  
PATENT L.R. 3.3**

Defendant The Black & Decker Corporation (“Black & Decker”) makes the following supplemental disclosure of its Preliminary Invalidity Contentions as required under Patent L.R. 3.3. Defendant states that this is the statement of The Black & Decker Corporation and not the statement of any other defendant added to this action by the court’s ruling on Plaintiff’s motion to join additional parties.

Plaintiff's preliminary infringement contentions pursuant to Patent L.R. 3.1 identify only claim 1 of U.S. Patent No. 4,935,184 ("the '184 patent") as being asserted against Black & Decker. If additional claims are asserted, Black & Decker reserves the right to supplement its invalidity contentions to address all later asserted claims.

1 Black & Decker contends that Plaintiff's own claim construction contentions (as set  
 2 forth, for example, in Plaintiff's Memorandum in Support of Summary Determination of  
 3 Infringement, Doc. #33) render claim 1 invalid over the prior art. Black & Decker does not  
 4 agree with the Plaintiff's claim construction (in fact, Black & Decker contends that many of the  
 5 terms are incapable of reasonable construction as described in Section D. below) but has applied  
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 8 construction position in the time and manner required under Patent L.R. 4.1.

9 **A. The Identity of Prior Art**

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8	App. No. GB 2004 494 A	UK	April 4, 1979 (Pub. Date)
9	Pub. No. WO 87/012329	PCT/Priority U.S.	March 12, 1987 (Pub. Date)
10	Pub. No. 1 850 999	Germany	May 3, 1962 (Pub. Date)

**Prior Art Publications**

	<u>Title</u>	<u>Date of Publication</u>	<u>Author</u>	<u>Publisher</u>
17	Multi-Color Injection Moulding Machines for the Processing of Thermoplastic Materials	1983	Reiner Jensen	Krauss-Maffei AG
18	Promat 100-100/100 by Nestal		Nestal	Nestal
19	New Vigor for Two-Shot Molding with Automation ... Versatility ... Ingenuity	May 1968	Val Wright	Modern Plastics

**Prior Art Under 35 U.S.C. §102(b)**

<u>Description of Item</u>	<u>Action Date</u>	<u>First Party</u>	<u>Second Party</u>

1	Parking Brake Grip	9/10/82 to 7/2/86	Phillips Plastics Corp.	Atwood Automotive
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3	Knob Infinite Switch	1/22/87 to 2/5/87	Phillips Plastics Corp.	Jenn-Air Corp.
4	Button Release Assembly	11/14/84 to 2/5/87	Phillips Plastics Corp.	Eastman Kodak
5	S Series Camera Body	6/14/86 to 2/5/87	Phillips Plastics Corp.	Eastman Kodak
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7	Set-Coast Switch, Part No. B9207-C	8/8/85 to 10/85	Phillips Plastics Corp.	Methode Electronics
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10	BMW 528i Part No. 63 21 1 361 603	1979	Krauss-Maffei AG	BMW
11				
12				
13				

14                   **B. Whether each item of prior art anticipates each asserted claim or renders it**  
 15                   **obvious.**

16                   Black & Decker contends that the following references anticipate claim 1 of the '184  
 17 patent: see Section C, Table 1.

18                   Black & Decker contends that the following references in combination render obvious  
 19 claim 1 of the '184 patent: see Section C, Table 2, and Table 3 Figures A, D, F and G.

## **EXHIBIT E**

**Notice of Changes in Requirement  
for a Substantial New Question of Patentability for  
a Second or Subsequent Request for Reexamination  
While an Earlier Filed Reexamination is Pending**

**A. Summary:** The United States Patent and Trademark Office (Office) revised section 2240 of the Manual of Patent Examining Procedure (MPEP) in May of 2004 to set forth a new policy when a second or subsequent request for reexamination is filed while an “earlier filed reexamination” is **pending**, and the second or subsequent request cites only prior art (hereinafter “old art”) which raised a substantial new question of patentability (SNQ) in the pending reexamination proceeding. See MPEP § 2240 (8<sup>th</sup> ed. 2001)(Rev. 2, May 2004). Under the new policy, the second or subsequent request for reexamination will be ordered **only** if that old prior art raises a substantial new question of patentability which is **different** than that raised in the pending reexamination proceeding. If the old prior art cited (in the second or subsequent request) raises only the same issues that were raised to initiate the pending reexamination proceeding, the second or subsequent request will be denied.

It is to be noted that reliance on prior art cited in the pending reexamination (old art) does not preclude the existence of a SNQ that is based exclusively on that old art. Determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request. The presentation/viewing of old art in a new light, or in a different way, is discussed in Ex parte Chicago Rawhide, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

**B. Background:** A request for ex parte reexamination of a patent pursuant to 35 U.S.C. 302, and a request for inter partes reexamination of a patent pursuant to 35 U.S.C. 311, must raise a substantial new question of patentability (SNQ) in order for a reexamination of the patent to be initiated. More than one reexamination request may be filed for the same patent, and a second or subsequent reexamination request for reexamination of a patent, where a first reexamination proceeding is pending, has historically been granted based on the **same** prior art that raised the SNQ in a pending first reexamination proceeding.

It has been the Office’s experience, however, that both patent owners and third party requesters have used a second or subsequent reexamination request (based on the same substantial new question of patentability initially raised or existing in the pending reexamination proceeding) to prolong the reexamination proceeding, and in some instances, to turn it essentially into an inter partes proceeding. These actions by patent owners and third party requesters have resulted in multiple reexaminations taking years to conclude, thus making it extremely difficult for the Office to conclude reexamination proceedings with “special dispatch” as required by statute (35 U.S.C. 305 for ex parte reexamination, 35 U.S.C. 314 inter partes reexamination). For example, under the prior practice, a patent owner whose claims are rejected in a pending

reexamination proceeding could repeatedly file multiple ex parte reexamination requests based on the same substantial new question of patentability raised, or existing, in the pending reexamination proceeding. By doing so, the patent owner could keep the reexamination proceeding pending indefinitely, to delay the issue of a reexamination certificate canceling the claims of the patent being reexamined. Additionally, a third party requester could file a second or subsequent reexamination request, while a first reexamination proceeding is pending, based on the same substantial new question of patentability raised, or existing, in the first reexamination proceeding, in order to address any responses to Office actions made by the patent owner. This use of a second or subsequent reexamination request has permitted third party requesters to, in effect, obtain an inter partes type of reexamination process in an ex parte reexamination proceeding.

Moreover, concerns regarding lengthy ex parte reexamination pendency resulting from multiple reexamination request filings were raised by witnesses at the Office's Round Table on the Equities of Inter Partes Reexamination Proceedings held February 17, 2004.

**C. Implementation of New Policy:** Responsive to these concerns, the Office revised its policy to be as is now set forth in the current (May 2004) revision of MPEP § 2240, that is: **the SNQ for a second or subsequent request for reexamination must be new and different than any SNQ that was raised, or existed, during any prior pending or concluded reexamination proceeding for the patent.** This revised policy is consistent with the statutory mandate of special dispatch and the intent of the ex parte reexamination statute (an ex parte reexamination proceeding is not an inter partes type of reexamination process). Further, 35 U.S.C. 303(a) states that “[w]ithin three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request.” It is reasonable to interpret this provision as requiring each request for reexamination to raise its own substantial new question of patentability as compared not only to the original prosecution (in the application for the patent) and any earlier, concluded reexamination proceedings, but to pending reexamination proceedings as well. To accompany the revision of MPEP § 2240, MPEP § 2640, which was newly added to the MPEP in May of 2004 to address inter partes reexamination proceedings, was drafted to implement this revision of policy for inter partes reexamination proceedings.

**D. Transition Procedure:** It is noted that, as a consequence of the changes made to MPEP § 2240, a patent owner will now be prevented from obtaining entry of an amendment and/or evidence not entered after final rejection in an ex parte reexamination proceeding by filing another request for reexamination based on the same substantial question of patentability raised/existing in the pending reexamination proceeding. In order to provide relief to the patent owner, the Office plans to propose a revision to the patent rules to provide for the filing of a request for continued reexamination (RCR) which would be similar to the request for continued examination (RCE) practice for applications. If the RCR practice is implemented, the patent owner, by filing an RCR, could obtain continued prosecution on the merits in the reexamination

proceeding, including entry of an amendment and/or evidence that was denied entry after a final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding.

Until these new rules become effective, however, patent owners are advised to use either: (1) the petition procedure under 37 CFR § 1.181 to seek review of a denial of entry of an amendment submitted after final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding; or (2) the petition procedure under 37 CFR § 1.182 to seek relief that is not currently provided by an existing rule, but that would be provided when a new request for continued reexamination (RCR) practice is in effect.

**E. Inquiries:** Inquiries regarding this matter may be directed to Kenneth M. Schor, Senior Legal Advisor, Office of Patent Legal Administration at telephone: (571) 272-7710.

Date: 2/2/05

Signed: /S/

JOSEPH J. ROLLA  
Deputy Commissioner  
for Patent Examination Policy